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OFFICE OF PETITIONS

In re Application of	:	
Besen et al.	:	ON APPLICATION FOR
Application No. 10/726814	:	RECONSIDERATION OF
Filing or 371(c) Date: 12/03/2003	:	PATENT TERM ADJUSTMENT.
Attorney Docket Number:	:	
15815US02	:	

This is a decision on the "APPLICATION FOR RECONSIDERATION OF THE DETERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b) ACCOMPANYING THE NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)," filed June 14, 2010. Applicants petition for reconsideration of the patent term adjustment calculation to 1853 days, not 963 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon (1) on the basis that the Office will take in excess of three years to issue this patent, and (2) an assertion that the Office erred in calculating a delay of 1 day. The petition is properly treated under 37 C.F.R. § 1.705(b).

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in failing to calculate a delay of 1 day is **DISMISSED**.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b), and as it relates to the Office's failure to calculate a delay of 18 days under 37 CFR 1.704(c)(10), is **DISMISSED as PREMATURE**.

On March 16, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 963 days.

On June 14, 2010, applicant timely submitted the instant application for patent term adjustment¹. Applicants request that the Determination of Patent Term Adjustment be corrected from 963 days, as indicated on the Determination of PTA mailed March 16, 2010, to an adjustment of 1853 days. Applicants aver that the Office may have erred in failing to calculate an adjustment 1 day.

Applicant requests that the Office adjust the patent term adjustment ("PTA") pursuant to 37 CFR 1.704(b) to 0 days. Applicant believes that it should not have been assessed one (1) day of delay relative to the filing of the reply to a non-final Office action, three months and one (1) day after the mail date of the non-final Office action. Applicant acknowledges that the date three months after the mailing of the non-final Office action is May 17, 2009, and that the reply to the non-final Office action was filed on May 18, 2009. However, Applicant avers that the reply was timely because the time period for reply ended on a Saturday, Sunday or Federal Holiday, in which instance, Applicant provides, the reply is timely if filed on the next succeeding business day. Applicant cites to 37 CFR §§ 1.6(a)(1) and 1.7, and provides in relevant part, that when the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on a Saturday, Sunday or on a Federal Holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday or a Federal Holiday.

Regarding the delay of one (1) day attributed to Applicant under 37 CFR 1.704(b), for filing the reply to the non-final Office action on May 18, 2009, Patentee's attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. That is, while the date indicated on any certificate of mailing or transmission under § 1.8 will continue to be taken into account in determining timeliness, the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation. Applicant may wish to consider the use of the "Express Mail Post Office to Addressee" service of the United States Postal Service (§ 1.10) or facsimile transmission (§ 1.6(d)) for replies to be accorded the earliest possible filing date for patent term adjustment calculations. (Emphasis supplied). *See also*, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

In accordance with 37 CFR 1.703(f), the Office properly used May 18, 2009, the filing date of the reply to the non-final Office action, in calculating the patent term adjustment. Accordingly, Patentees' argument on request for reconsideration of patent term adjustment is not found persuasive.

It is also noted that the petition fails to account for reductions of 27 days in connection with the filing of the Notice of Appeal on September 24, 2008, in reply to the final Office action, mailed May 28, 2008, and of 30 days in connection with the filing of the Amendment on December 4, 2009, in reply to the non-final Office action, mailed August 4, 2009. Pursuant to 37 CFR 1.704(b), reductions of 27 days, beginning on the day after the date that is three months after the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request, August 29, 2008, and ending on the date the reply was filed,

¹ PALM records show that the Issue Fee payment was received in the Office on June 16, 2010.

September 24, 2008, and of 30 days, beginning on the day after the date that is three months after the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request, November 5, 2009, and ending on the date the reply was filed, December 4, 2009, were properly assessed to Applicant.

As to the Office's failure to issue the patent within 3 years of the filing date, and as to the Office's failure to assess a reduction of 18 days in connection with the Information Disclosure Statement ("IDS"), filed May 24, 2010, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

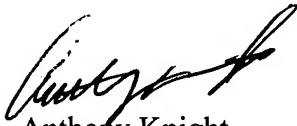
Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date,

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and *must* include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions